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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENRY, JON W

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/659,375

Applicant(s)

TAKAHASHI, TOMOWAKI

Examiner

Jon W. Henry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on April 13, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 and 58 is/are allowed.
- 6) ☒ Claim(s) 27-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION*****Reissue Applications***

1. The reissue oath/declaration filed with this application is sufficient with regard to claims 1-26 and 58. See MPEP 1402. The reissue oath/declaration is defective, with regard to claims 27-57, because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See In re Weiler, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986).

Applicant asserts in item no. 7 of the declaration filed November 21, 2000, an error drafting claims 1 and 10 of the patent unduly narrowly, which error has been corrected in at least claim 27. However, claim 27, as well as claims 28-57, are also narrower than any patent claims by at least the recitation of "dioptric" and none of the claims newly presented in reissue are purely narrower than any of the patent claims. That is, all newly presented claims include separate features from all of the patent claims. Additionally, no linking claim, allowable or otherwise, has been presented to indicate the inventions claimed in the patent have unity of invention with the inventions claimed in the claims newly presented in reissue. In fact, it appears the patentability of the claims newly presented in reissue and the patent claims, if any, is related to the separate features of the inventions. The fact that the common subject matter of the patent claims and claims newly presented in reissue do not appear to relate to an unclaimed allowable linking claim directed to the newly claimed subject matter minus the recitation of "dioptric" is emphasized by reference to the Fig. 7 embodiment of Suenaga et al that may anticipate or at least make obvious such subject matter newly claimed in reissue "but for" the recitation of "dioptric." Therefore, it appears the claims newly presented in reissue relate to subject matter "entirely distinct" from anything earlier claimed or attempted or intended to be claimed. See In re Weiler,

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790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986). Additionally, the original patent claims have not been changed at all, and therefore it appears any statutory error would have to relate to the claims newly presented in reissue.

Applicant's statements in his declaration, including item no. 7, do not address how (1) the inventions newly claimed in reissue are not directed to "entirely distinct" inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (2) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but *Weiler* is not controlling case law in this instance. Therefore, it appears applicants' declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

2. Claims 27-57 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above.

#### ***Allowable Subject Matter***

3. Claims 1-26 and 58 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter. The prior art does not teach or fairly suggest the subject matter of the allowed independent claims. In particular, claim 58 is allowable for the reasons set forth in applicant's remarks.

#### ***Response to Arguments***

5. When applicant first presented new claim 58 in the amendment received September 18, 2001, applicant's remarks, page 3, lines 7-10, recited: "it is respectfully submitted that the Applicant has both provided a claim that is purely broader than any of the issued claims, and also

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has the unity of invention required by the Examiner's novel interpretation of In re Weiler, et al., 229 USPQQ 673 (Fed. Cir. 1986)." In fact, the unity of invention "required by" the Examiner is that required by the court in Weiler, and may be related to *a claim that links the invention(s) newly presented in reissue with an invention claimed in the patent.*

At least partially relying on the above quoted assertion of applicant, the Examiner proceeded to examine claim 58 as such a linking claim. That was a mistake. Claim 58 does not link the patented inventions to the inventions newly claimed in reissue. In fact, claim 58 is very similar to patent claim 18. Claim 58 clearly is not a linking claim for the claims newly presented in reissue because claim 58 has separate features from the other claims newly presented in reissue, as previous Office actions make clear. However, examination of the patent claims, and new claim 58 is appropriate now. See MPEP 1402.

Applicant's remarks, pages 11 and 12, may properly state that claim 58 is an allowable linking claim for the patent claims. However, the issue for the examination of the claims newly presented in reissue is whether claim 58 links the inventions of the claims newly presented in reissue to any of the inventions of the patent claims, which it clearly does not.

Applicant's remarks, page 11, lines 2-8 recite: "The Court [in Weiler] held that, since the applicant failed to timely file a divisional application during pendency of the application, the applicant was not allowed to cure this error in a reissue application since, as evidenced by the restriction requirement, the reissue application was not directed to the same invention. In re Weiler is therefore consistent with In re Amos, 21 USPQ2d 1271 (Fed. Cir. 1991) in not allowing a reissue claim drawn to a different invention in cases where evidence exists in the record that the inventions are different." The argument, that a restriction requirement was

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critical to the decision in Weiler, on which the quoted statements are based, is neither new nor novel. In fact, that argument was thoroughly refuted previously in the prosecution of this application. See, for example, pages 4-5 of the final rejection mailed May 29, 2001. However, the argument keeps returning.

In fact, it appears that the argument is so weak that its main value, in the statements now presented, is in terms of confusing the issues in this application. In particular, the argument is now used in conjunction with terms with no clear meaning and that are irrelevant to the issues. In this case, applicant confuses the issues in this application by the reference to "same invention" in the remarks, page 11, lines 3-7, quoted above. The term "same invention" may mean various things, including identical inventions (see MPEP 804) or "same patentable invention" (see 37 CFR 1. 601(n)). However, the issue of "same invention" is irrelevant to the issues in this application that concern "entirely distinct" inventions. In fact, even if Amos were controlling in this case, which it clearly is not, the issue of "same invention" would be irrelevant (see Amos, 21 USPQ2d 1271, 1275 (Fed. Cir. 1991)). Applicant's statement that "evidence exists in the record that the inventions are different" is clearly erroneously with regard to "evidence" existing because there was no evidence with regard to the claims at issue because they were not presented until reissue. Additionally, the reference to "the inventions are different" merely sows the same confusion as the reference to "same invention" with regard to what is meant by "are different." Of course, all of the claimed inventions were "different" from one another if they included additional or separate features from the other claimed inventions.

In any case, applicant's statement, quoted above, incorrectly states the standard of Weiler. The correct standard of Weiler, as set out in the first Office action, page 5, lines 10-22,

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mailed February 13, 2001, by directly quoting the decision in Weiler, as follows: "The board's language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender. In re Weiler, 790 F2d, 1581, \_\_\_, 229 USPQ 673,675 (Fed. Cir. 1986)." The problem (for the appellant) in Weiler was that the appellant sought to patent via reissue subject matter that was "entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed," which clearly included the subject matter of claims that had been restricted. That is, the distinction was that subject matter that was newly presented in reissue was "entirely distinct" from anything ever claimed, attempted to have been claimed, or intended to have been claimed in the prosecution of the original application that matured into a patent. In other words, the fact that there had been a restriction requirement was irrelevant to the decision in Weiler. It is simply impossible to reasonably conclude that the fact that a restriction requirement had been made previously made any difference in the decision in Weiler.

Applicant's remarks, page 10, lines 1-3, recite "Specifically, subsequent case law, such as In re Amos, 21 USPQ2d 1271 (Fed. Cir. 1991), has effectively eviscerated the interpretation proffered by the Examiner." Applicant's remarks provide no support for that assertion. As applicant's remarks more correctly state, and contrary to earlier positions applicant has taken in this application, Weiler and Amos are consistent with one another. In fact, Amos, and Hounsfield before it (and before Weiler), concerned the PTO taking the unreasonable position that if an applicant had not claimed an invention during the prosecution of the original application that was patented, the applicant could not obtain reissue examination of that

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invention because the prosecution history of the original application did not demonstrate an “intent to claim” that invention originally. On the other hand, if the applicant had attempted to, but failed to claim the invention originally, the applicant would be prevented from having the invention examined based on the recapture doctrine. Therefore, an applicant was caught “between a rock and a hard place” in reissue and might have a very difficult time obtaining reissue examination of anything. Consequently, the reissue statute was “eviscerated,” to use applicant’s terminology, until the court reversed the PTO decisions.

Of course, applicant wants to rely on Amos because the claims to “entirely distinct” inventions are directed to subject matter disclosed in the original specification. However, Weiler clearly refuted the argument such disclosure was a sufficient basis for reissue examination with regard to claims 13 and 19, the only claims on appeal in Weiler, as follows: “Weiler’s argument that the subject matter of claims 13 and 19 does not constitute ‘an independent and distinct invention’ merely because that subject matter can be found somewhere in the overall disclosure of the ‘923 patent is meaningless...the subject matter must have been disclosed, § 112, or there is no basis for discussing whether the invention being claimed on reissue is independent or distinct.” In re Weiler, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 676 (Fed. Cir. 1986).

As stated above, applicant’s assertion that the fact that a restriction requirement had been made in the prosecution of the original patent to Weiler et al determined the outcome in Weiler is logically in error. The court in Weiler did state various relationships of distinctness: “The subject matter of [appealed claims] 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10.” In re Weiler, 790 F.2d 1581, \_\_\_,



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229 USPQ 673, 676 (Fed. Cir. 1986). However, the court and the parties in Weiler understood the issue was whether the claims on appeal were “independent and distinct” from the patent claims: “Weiler says the subject matter of neither claim 13 nor claim 19 constitutes ‘an independent and distinct invention’ from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent.” In re Weiler, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986).

It was, of course, the separate features of the patent claims and the claims on appeal that determined the inventions were “independent and distinct.” However, the court did not state the rule of the case in terms of “independent and distinct” inventions but rather in terms of “entirely distinct” inventions. “The board’s language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender.” In re Weiler, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986). Additionally, the court in Weiler identified the part of statutory provision of 35 USC 251 at issue was statutory error, not sufficiency of disclosure under 35 USC 112, first paragraph. “Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established ‘error’ which can be remedied by reissue.” In re Weiler, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677 (Fed. Cir. 1986).

Additionally, it was not only the “independent and distinct” aspect of the reissue claims that the court weighed in finding lack of statutory error. The court also stated: “Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did,

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of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an appellant point out and distinct claim subject matter he regards as his invention. 35 U.S.C. § 112, 2d ¶.2” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 676 (Fed. Cir. 1986). The requirements of 35 USC 112, second paragraph, also weigh against finding statutory error in the instant application.

Furthermore, the court associated its refusal to find statutory error in newly claiming an entirely distinct invention in reissue to another part of the reissue statute. “Moreover, § 251 authorizes reissue for ‘the’ invention disclosed in the original patent, not for just ‘any’ and ‘every’ invention for which one may find some support in the disclosure of the original patent.” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 676 (Fed. Cir. 1986). The court’s interpretation of that part of the reissue statute also applies equally well to the instant application. In spite of the fact that the decision in *Weiler* is clearly controlling in this application, applicant continues to argue that *Amos* is the controlling case law. Applicant’s comments totally ignore the fact that *Amos* did not concern issues of “independent and distinct” inventions, “entirely distinct” inventions, patentably distinct inventions, or any similar issues that might be considered relevant in determining if the declaration in this reissue application is sufficient. In fact, the court in *Amos* clarified it was not making any new law but was merely reiterating case law set forth before *Weiler* (and therefore logically could not define any new limitation on *Weiler* as applicant suggests): “Our decision in this circumstance is dictated by this Court’s previous decision in *In re Hounsfield*, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983).

Applicant’s remarks, page 6, assert that “it is unclear how the mere addition of the

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term “dioptric” to a feature of new claim 27 necessarily narrows the overall scope of new claim 17 to be narrower than the original patent claims. To clarify the Examiner’s position, the reason is that the feature of “dioptric” is not in any of the patent claims. Additionally, as applicant’s heading “A.” of page 6 of the remarks, indicate, applicant is well aware that the claims newly presented in reissue are also broader than the patent claims in some respects. That fact has been pointed out repeatedly in the prosecution of the this application in terms of “separate features” of the inventions and in terms of “entirely distinct” inventions.

Therefore, applicant’s heading “A. Examiner Has Not Provided Evidence That The New Claims are Purely Narrower” is clearly in error. Claims newly presented in reissue that are purely narrower claims are commonly proper for reissue examination and cannot raise any issue of “entirely distinct” or of linking claims because they do not relate to separate features between all of the patent claims and claims newly presented in reissue.

Applicant’s remarks, pages 9 and 10, further argue Amos versus Weiler. That case law has been thoroughly covered. See, e.g., the Office actions mailed February 13, 2001, May 29, 2001, and October 31, 2001. As discussed in those Office actions, Amos has nothing to do with the issues in this case. Although applicant might like Weiler to be “no longer the current state of the law” (see applicant’s remarks, page 10, lines 3-5), applicant provides no evidence of that, other than that the MPEP does not cite Weiler. It appears that the applicant is led to that position based on two facts: (1) Applicant cannot find any MPEP section that addresses the issues in this case; (2) Applicant does not like the decision in the case law that does apply, namely, Weiler. In fact, it appears that applicant’s position is that even though Weiler is the current law, and even though it is law on point to the issues in the application, it is not the law

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because the MPEP does not cite Weiler.

Applicant's remarks, page 10, lines 15-18, recite: "To the extent that the Examiner's statements are contrary to the instructions contained in the MPEP, it is noted that the Examiner's [sic] is acting *ultra vires*...." Applicant is requested to explain how the Examiner's statements are contrary to the instructions contained in the MPEP. In fact, it appears that is merely a veiled argument concerning Amos being controlling in this case, an argument that the court in Amos apparently foresaw and went to extraordinary lengths to prevent in footnote 3 of Amos, as follows:

Neither party nor the Board cited or discussed this case [Hounsfield]. Inexplicably, all three rely instead on dicta from Weiler. The issue for decision in Weiler was whether the patentee had demonstrated error without deceptive intention, not whether the claims were to the same invention as the "original patent." We do not quibble with the holding in Weiler that satisfaction of the § 112 ¶ 1 written description requirement does not establish "error" with § 251. Weiler, 790 F.2d at 1581 n. 2, 229 USPQ 676 n.2. Weiler did not involve the question of whether § 112 ¶ 1 speaks conclusively to the "original patent" requirement of § 251... We have no ready explanation for the Board's or the parties' attention to Weiler and utter inattention to Hounsfield. (*In re Amos*, 953 F.2d 613, 619, 21 USPQ2d 1271, 1276 (Fed. Cir. 1991)).

It is not the Examiner who "may disagree with the current state of the law" (quoting

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Applicant's remarks, page 10, line 7), but Applicant who chooses to ignore the law he disagrees with, namely, Weiler because Weiler is not cited in the MPEP. In fact, it appears that underlying applicant's concern of an *ultra vires* action by the examiner is a recognition that if, as set out in Weiler, an applicant cannot establish statutory error under 35 USC 251 for subject matter newly claimed in reissue, an examiner has no authority to examine that subject matter under 35 USC 251, and to examine such subject matter without any authority for such examination would appear to be an *ultra vires* action. "Of course, an agency's interpretation of a statute it administers is entitled to deference... but 'the courts are the final authorities on issues of statutory construction. They must reject administrative constructions of the statute, whether reached by adjudication or by rulemaking, that are inconsistent with the statutory mandate of that frustrate the policy that Congress sought to implement.'" Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154, (Fed. Cir. 1988) (quoting Federal Election Comm'n v. Democratic Senatorial Campaign Comm., 445 U.S. 27, 32 (1981)).

Of course, applicant wants to rely on Amos because the claims to "entirely distinct" inventions are not directed to new matter but are supported by the existing specification. However, Weiler clearly refuted the sufficiency of original disclosure supporting reissue examination, with regard to claims 13 and 19, the only claims on appeal in Weiler, as follows: "Weiler's argument that the subject matter of claims 13 and 19 does not constitute 'an independent and distinct invention' merely because that subject matter can be found somewhere in the overall disclosure of the '923 patent is meaningless... the subject matter must have been disclosed, § 112, or there is no basis for discussing whether the invention being claimed on

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reissue is independent or distinct.” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 676 (Fed. Cir. 1986).

As stated above, applicant’s assertion that the fact that a restriction requirement had been made in the prosecution of the original patent to Weiler et al determined the outcome in *Weiler* is logically in error. The court in *Weiler* did state various relationships of distinctness: “The subject matter of [appealed claims] 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10.” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 676 (Fed. Cir. 1986). However, the court and the parties in *Weiler* understood the issue was whether the claims on appeal were “independent and distinct” from the patent claims: “Weiler says the subject matter of neither claim 13 nor claim 19 constitutes ‘an independent and distinct invention’ from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent.” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986).

It was, of course, the separate features of the patent claims and the claims on appeal that determined the inventions were “independent and distinct.” However, the court did not state the rule of the case in terms of “independent and distinct” inventions but rather in terms of “entirely distinct” inventions. “The board’s language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender.” *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986). Additionally, the court in *Weiler* identified

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the part of statutory provision of 35 USC 251 at issue was statutory error, not sufficiency of disclosure under 35 USC 112, first paragraph. "Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established 'error' which can be remedied by reissue." *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677 (Fed. Cir. 1986).

Additionally, it was not only the "independent and distinct" aspect of the reissue claims that the court weighed in finding lack of statutory error. The court also stated: "Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did, of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an appellant point out and distinct claim subject matter he regards as his invention. 35 U.S.C. § 112, 2d ¶.2" *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 676 (Fed. Cir. 1986). The requirements of 35 USC 112, second paragraph, also weigh against finding statutory error in the instant application.

Furthermore, the court associated its refusal to find statutory error in newly claiming an entirely distinct invention in reissue to another part of the reissue statute. "Moreover, § 251 authorizes reissue for 'the' invention disclosed in the original patent, not for just 'any' and 'every' invention for which one may find some support in the disclosure of the original patent." *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 676 (Fed. Cir. 1986). The court's interpretation of that part of the reissue statute also applies equally well to the instant application. In spite of the fact that the decision in *Weiler* is clearly controlling in this application, applicant continues to argue that *Amos* is the controlling case law. Applicant's comments totally ignore

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the fact that Amos did not concern issues of “independent and distinct” inventions, “entirely distinct” inventions, patentably distinct inventions, or any similar issues that might be considered relevant in determining if the declaration in this reissue application is sufficient. In fact, the court in Amos clarified it was not making any new law but was merely reiterating case law set forth before Weiler (and therefore logically could not define any new limitation on Weiler as applicant suggests):

“Our decision in this circumstance is dictated by this Court’s previous decision in In re Hounsfield, 699 F.2d 1320, 216 USPQ 1045 (Fed. Cir. 1983). [footnote 3, quoted above]....Thus, we conclude, as did this Court in Hounsfield, that the presence of absence of an objective intent to claim, standing alone, is simply not dispositive of any required inquiry under § 251.” In re Amos, 953 F.2d 613, \_\_\_, 21 USPQ2d 1271, 1276 (Fed. Circuit. 1991). Additionally, Weiler cites Hounsfield and explains that Hounsfield concerned not the statutory error issue of Weiler, and of the instant application, but the issue of “intent to claim” that relates merely to a threshold issue of finding “statutory error” in terms of the reissue claims having 35 USC 112, first paragraph, support in the original application. In re Weiler, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677 (Fed. Cir. 1986).

In view of (a) applicant’s failure to explain why Weiler is not controlling case law in this application in terms of how (1) the inventions newly claimed in reissue are not directed to “entirely distinct” inventions and therefore Weiler is not controlling case law with regard to



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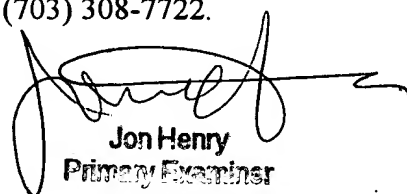
finding applicant has failed to establish statutory error or (2) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but Weiler is not controlling case law in this instance, and (b) the factors considered in Weiler in determining insufficiency of the reissue declaration weigh similarly in determining insufficiency of the reissue declaration in this application, the examiner must reject claims 27-57 as being based upon a defective reissue declaration under 35 USC 251 as set forth above.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.



Jon Henry  
Primary Examiner